

REMARKS

Claims 1-9, 11-13, 48-49, 54-55, 59-60, 64-65, and 67-68 are pending in the application. Claims 10, 51-53, 56-58, 61-63, 66, and 69-71 are withdrawn. Applicants reserve the right to prosecute the withdrawn subject matter, as well as the originally presented claims, in continuing applications. Applicants also reserve the right to rejoin the withdrawn claims drawn to non-elected species upon allowance of a generic claim. No claim amendments have been presented herein. Accordingly, no new matter has been added by this filing.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-9, 11-13, 48-49, 54-55, 59-60, 65 and 67-68 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,011,040 by Muller et al. (“Muller”) in view of U.S. Patent No. 5,716,941 by Rabinoff et al. (“Rabinoff”) and U.S. Patent No. 5,603,959 by Horrobin et al. (“Horrobin”) and further in view of International Publication No. WO 98/19690 by Smith *et al.* (“Smith”) and U.S. Patent No. 5,997,915 by Bailey *et al.* (“Bailey”).

Applicants traverse these rejections on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires that “either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *See* MPEP 706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Knowledge of the disclosure provided by the instant application must be put aside when determining whether the claimed invention would have been obvious. *See* MPEP 2142.

To support the conclusion that the claimed invention is directed to obvious subject matter, the Examiner has cited and combined no less than five references. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one ordinary skill in the art. *See* MPEP §2143.01, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385, 1396 (2007). Furthermore, a statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of


obviousness without some objective reason to combine the teachings of the references. *See* MPEP §2143.01, citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

There is no objective reason provided by the Muller, Rabinoff, Horrobin, Smith and Bailey references, alone or in combination, that would lead the skilled artisan to combine these references, nor is there any evidence that the resultant combination of these reference would have been predictable. Moreover, these references fail to provide the skilled artisan with a reasonable expectation that the compositions recited by the amended claims presented herein would successfully produce a chondroprotective effect. Any suggestion that the claimed compositions would have been obvious or that the resultant chondroprotective effect would have been predictable is an improper application of hindsight based on Applicants' disclosure in the instant application. Thus, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness and request that this rejection be withdrawn.

CONCLUSION

Applicants submit that the application is in condition for allowance and such action is respectfully requested. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact any of the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No.21629-004.

Respectfully submitted,

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